

**BARNES & THORNBURG LLP**

600 One Summit Square  
Fort Wayne, Indiana 46802  
(260) 423-9440

**PATENT APPLICATION  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Customer No.:	23641	}	
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Application No.:	09/804667	}	
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Confirmation		}	
No.:	1994	}	
		}	
Filing Date:	March 12, 2001	}	I hereby certify that this correspondence is being electronically filed with the United States Patent and Trademark Office.
		}	
Attorney		}	
Docket No.:	37168/82320	}	on <u>June 13, 2007</u>
		}	
First Named		}	
Inventor:	Schwartz, Denis G.	}	
		}	
Group Art		}	
Unit:	3624	}	
		}	
Examiner		}	
Name:	Jocelyn Greimel	}	
		}	
Title:	Method and Apparatus for	}	
	Providing Retirement Income	}	
	Benefits	}	

/BBG/  
Bobby B. Gillenwater

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a Supplemental Information Disclosure statement filed to apprise the Examiner of a recent development in connection with the parent application (Serial No. 09/406,290, now U.S. Patent No. 7,089,201) (the “’201 Patent”) to which the present application claims priority.

The ‘201 Patent is the subject of litigation in the United States District Court for the Northern District of Iowa. The Plaintiff in that action is Transamerica Life Insurance Company, et al. (“Transamerica”) and the Defendant is Lincoln National Life Insurance Company

("Lincoln"), the assignee of the present application. On June 1, 2007, Transamerica filed a document pursuant to the court's scheduling order outlining defenses it proposes to assert to counterclaims in the subject litigation. As part of that filing, Transamerica has asserted that the '201 Patent is invalid/unenforceable because of inequitable conduct before the Patent Office. Pages 13-15 of the subject filing is attached to this disclosure statement for the Examiner's review.

The subject filing lists 12 documents and 4 U.S. patents which are alleged to have been withheld from the Patent Office in connection with the '201 Patent. It is applicants' and the undersigned's position that none of these documents and/or U.S. patents would have been material to the examination of the '201 Patent.

Of the 12 documents and 4 U.S. patents listed in the court filing, all of the U.S. patents and 2 of the documents are of record and have already been considered by the Examiner in this application. Copies of the 10 remaining documents accompany this Supplemental Information Disclosure Statement. It is applicants' and the undersigned's position that none of these documents are material to the examination of the present application. They are being cited solely because this issue has been raised (baselessly, we believe) in the litigation involving the parent case. Indeed, most of the documents attached are either undated or dated after the September 25, 1998, priority date of the present application, and some, without further evidence, do not automatically qualify as publications under Section 102 (e.g., the internal memorandum, the PowerPoint presentations and "handout"). Nevertheless, the documents have been listed on the attached Form 1449.

It is respectfully requested that these documents be expressly considered during the prosecution of this application, and that the documents be made of record therein and appear

among the "References Cited" on any patent to issue therefrom.

The citation of these documents shall not be construed to be an admission that the information therein is considered material to patentability of the present claims, nor is the citation of these documents an admission that the documents constitute prior art.

This Supplemental Information Disclosure Statement is being filed more than three months after the U.S. filing date OR after the mailing date of a first Office Action on the merits. Therefore, a fee of \$180.00 is enclosed herewith.

Please charge any additional fees that might be due in connection with this Supplemental Information Disclosure Statement or credit any overcharges to Barnes & Thornburg LLP Deposit Account No. 02-1010 (37168/82320).

Respectfully submitted,

/BBG/  
Bobby B. Gillenwater  
Reg. No. 31,105  
(260) 423-9440

Date: June 13, 2007

<p style="text-align: center;">U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE</p> <p style="text-align: center;"><b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b></p> <p style="text-align: center;">(Use several sheets if necessary)</p>	Complete if Known	
	Application Number	09/804667
	Filing Date	March 12, 2001
	First Named Inventor	Schwartz, Denis G
	Group Art Unit	3624
	Examiner Name	Jocelyn Greimel
Sheet 1 of 3	Attorney Docket Number	37168/82320

A U.S. PATENT DOCUMENTS					
*Examiner Initials	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
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	A.22				

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\*EXAMINER: Initial reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kind Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Send to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450. (Rev. 08/03)

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Sheet 2 of 3	Attorney Docket Number	37168/82320

B FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)				
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	Group Art Unit	3624
	Examiner Name	Jocelyn Greimel
Sheet 3 of 3	Attorney Docket Number	37168/82320

c OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	C.1	Annuity Market News, "VA Patent Skirmishes in the Making?" September, 2005	
	C.2	Sutherland, Asbill, & Brennan, LLP, Page 4 of an article discussing Minnesota Mutual Life Insurance Company's Guaranteed Minimum Annuity Payment Amount. (undated)	
	C.3	Memorandum from Ron Ziegler RE: Minnesota Mutual's Adjustable Income Annuity/Product Idea, January 14, 1997.	
	C.4	Steve McDonnell, "VA Guaranteed Payout Floor Riders Stress the Annuitized Approach" September 20, 2005	
	C.5	Kerry Geurkink, "Creativity in the Annuity Payout Phase" (PowerPoint Presentation), June 11, 1998.	
	C.6	Deanne Osgood, "Industry Research: VA Guaranteed Living Benefits" (PowerPoint Presentation) June 11-12, 1998.	
	C.7	Tillinghast-Towers Perrin, "The Variable Immediate Annuity Marketplace," handout dated August 25, 1998	
	C.8	Christine Ong, "Hartford Readies For-Life Withdrawal Benefits" (online article found at <a href="http://www.ignites.com">http://www.ignites.com</a> ; September 29, 2005	
	C.9	PR Newswire Online Article, "The Hartford Launches Innovative Benefit To Guarantee Principal of Variable Annuity Investors" July 26, 2002.	
	C.10	PR Newswire Online Article, "Fortis First to Market With an Unmatched Income Benefit," September 28, 1999, found at: <a href="http://www.prnewswire.com">www.prnewswire.com</a> .	

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requirement of §112 first paragraph and the "definiteness" requirement of §112 second paragraph.

- Claim 38 is invalid under 35 U.S.C. § 112 because it sets forth a formula that is not found anywhere in the '201 Patent specification. Therefore, claim 38 is invalid for failing to meet the "enablement" requirement of §112 first paragraph and the "definiteness" requirement of §112 second paragraph.

### **The '201 Patent is Invalid/Unenforceable because of Inequitable Conduct**

A patent is unenforceable if it is procured by inequitable conduct. One form of inequitable conduct involves the failure to disclose material information to the Patent Office during the pendency of a patent application with the intent to deceive the Patent Office. Impax Laboratories, Inc. v. Aventis Pharmaceuticals, Inc., 468 F. 3d 1366, 1374 (Fed. Cir. 2006). The duty to disclose material information applies to the inventors, as well as the patent attorney who prosecutes an application. 37 C.F.R. 1.56.

The following is a list of twelve documents that Transamerica provided to Barnes & Thornburg law firm in response to Interrogatory #8 in the ongoing litigation of U.S. Patent Number 6,611,815 in the Northern District of Indiana. Barnes & Thornburg is the law firm that prosecuted the '201 Patent. Transamerica provided this list of documents to Barnes & Thornburg on October 14, 2005. The '201 patent issued on August 8, 2006. These documents were never cited to the Patent Office by Barnes and Thornburg during the prosecution of the '201 patent. It is submitted that one of more of these references is material to the patentability of the '201 Patent and that Barnes and Thornburg was aware of these documents more than nine months before the '201 Patent issued but failed to cite these references to the Patent Office.

- Retirement Contribution Analyzer User Guide; Ernst & Young, LLP; Oct. 24, 1997; 19 pages.
- AnnuISHARE Lifetime Income Annuity Brochure, Form L30677 (4-97).
- Annuity Market News, "VA Patent Skirmishes in the Making?", September 2005.
- Sutherland, Asbill, & Brennan, LLP, Page 4 of an article discussing Minnesota Mutual Life Insurance Company's Guaranteed Minimum Annuity Payment Amount.

- Memorandum from Ron Ziegler RE: Minnesota Mutual's Adjustable Income Annuity/Product Idea, January 14, 1997.
- Steve McDonnell, "VA Guaranteed Payout Floor Riders Stress the Annuitized Approach" September 20, 2005.
- Kerry Geurkink, "Creativity in the Annuity Payout Phase" (Power Point Presentation), June 11, 1998.
- Deanne Osgood, "Industry Research: VA Guaranteed Living Benefits" (Power Point Presentation) June 11-12, 1998.
- Tillinghast-Towers Perrin, "The Variable Immediate Annuity Marketplace"; handout dated August 25, 1998.
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- PR Newswire Online Article, "The Hartford Launches Innovative Benefit To Guarantee Principal for Variable Annuity Investors" July 26, 2002.
- PR Newswire Online Article, "Fortis First to market With an Unmatched Income Benefit", September 28, 1999, found at: [www.prnewswire.com](http://www.prnewswire.com).

The duty to disclose relevant information also applies to prior art references cited in co-pending related applications. See McKesson Information Solutions, Inc. v. Bridge Medical, Inc., 2007 WL 1452731 (Fed. Cir. 2007). The following is a list of references that were cited in Lincoln National's earlier issued U.S. Patent Number 6,611,815 (the '815 Patent) relating to a data processing method for administering an annuity product having a guarantee of lifetime payments. These references were never cited to the Patent Office by Barnes and Thornburg during the prosecution of the '201 patent. Lincoln's '815 Patent issued on August 26, 2003. As noted above, the '201 patent issued on August 8, 2006.

- U.S. Patent No. 5,644,727 (Atkins).



- U.S. Patent No. 6,076,072 (Libman).
- U.S. Patent No. 6,148,293 (King).
- U.S. Patent No. 6,275,807 (Schirripa).
- Retirement Contribution Analyzer User Guide; Ernst & Young, LLP; Oct. 24, 1997; 19 pages.

Respectfully submitted,

/s/ Glenn Johnson  
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 SARAH J. GAYER AT0002757  
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 INSURANCE COMPANY, WESTERN  
 RESERVE LIFE ASSURANCE CO. of OHIO,  
 and TRANSAMERICA FINANCIAL LIFE  
 INSURANCE COMPANY, PLAINTIFFS